

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT E. SPITALETTA
and EDWARD C. SPITALETTA

Appeal No. 2004-0731
Application No. 09/957,059

ON BRIEF

Before BARRETT, BARRY, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 12 and 14-21¹², which are all of the claims pending in this application.

BACKGROUND

¹ An amendment (Paper No. 17, filed June 2, 2003) canceling claim 22, filed subsequent to the final rejection (Paper No. 7, mailed November 25, 2002), has been entered by the examiner (Paper No. 19, mailed June 24, 2003).

² The rejections of claims 12 and 14-22 under 35 U.S.C. § 103(a) and obviousness-type double patenting, have been withdrawn by the examiner (Paper No. 19, mailed June 24, 2003).

Appellants' invention relates to a nonreusable cellular telephone. An understanding of the invention can be derived from a reading of exemplary claim 12, which is reproduced as follows:

12. A cellular phone which is nonresettable and permanently rendered inoperative after the expiration of a predetermined period of calling time, comprising:

(a) a remaining time indicator provided with a preprogrammed, one-time predetermined period of calling time deductible from the cellular phone during cellular communications; and

(b) a microprocessor operative to control the operation of the cellular phone and (i) monitor the amount of time remaining of said predetermined period of calling time, (ii) allow the user to initiate and end calls and start and stop the deduction of the calling time so as to allow the user to make an initial call and one or more additional calls without regard to when said initial call was made and until said predetermined period of calling time is used up, and (iii) permanently disable the cellular phone once said one-time predetermined period of calling time has been used up such that the cellular phone is permanently rendered inoperative and incapable of any further use.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Norimatsu	5,438,612	Aug. 1, 1995
Rodriguez	5,983,091	Nov. 9, 1999
		(filed Jan. 25, 1995)
Crossley	GB 2 262 685 A	Jun. 26, 1993
(United Kingdom Patent Application)		

Claims 12 and 14-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Norimatsu in view of Crossley and Rodriguez.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 20, mailed July 29, 2003) for the examiner's complete reasoning in support of the rejection, and to appellants' brief³ (Paper No. 16, filed June 2, 2003) and reply brief (Paper No. 21, filed September 8, 2003) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered.

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer. Upon consideration of the record before us, we reverse.

³ Resubmitted Brief.

We observe at the outset appellants' assertion (brief, page 5) that all of the claims may be grouped together. Accordingly, we select claim 12 as representative of the group.

Turning to claim 12, we note that in rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness.

Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, pages 4-7) is that Norimatsu does not disclose the cellular phone to be nonresettable and rendered permanently inoperative. To make up for this deficiency of Norimatsu, the examiner turns to Crossley for a teaching of permanently rendering inoperative a cellular phone after a predetermined period of time. The examiner additionally asserts (answer, page 6) that Norimatsu does not disclose a remaining time indicator "for indicating a period of calling time provided and deductible from the cellular phone during cellular communications and to start and stop the deduction of calling time." To overcome this additional deficiency of Norimatsu, the examiner turns to Rodriguez for a teaching of a remaining time indicator for indicating a period of calling time provided and deductible from the cellular phone during cellular communications.

Appellants assert (brief, pages 10-13) that the references, even if taken in the combination proposed by the examiner, do not teach or suggest all of the limitations of claim 12. It is noted that claim 12 recites, inter alia, that "(b) a microprocessor operative to ... (ii) allow the user to initiate and end calls and start and stop the deduction of the calling time so as to allow the user to make an initial call and one or more additional calls without regard to when said initial call was made and until said predetermined period of calling time is used up." It is argued that one would not have been motivated to combine the permanently disabling feature of Crossley with the reusable telephones of Norimatsu and Rodriguez. It is additionally argued (reply brief, page 11) that there is no motivation to combine the teachings of Norimatsu and Rodriguez to provide Norimatsu with a remaining time indicator "'for the purpose of informing the user of the remaining amount of calling time left in the cellular phone of Norimatsu in order for the user to manage his remaining calling time.'" (Ex. Ans. at 7.)." Appellants argue (reply brief, page 11) that the modification would not have been obvious because in Norimatsu, one only needs to keep track of the elapsed rental period, not the remaining amount of calling minutes. Appellants maintain (reply brief, page 12) that "there would be no need, and no motivation, to keep track of the remaining amount

of calling time left in the phone to manage the remaining calling time since that remaining calling time *cannot* be managed in the first place."

From our review of the references, it would appear at first blush that appellants are correct that it would not have been obvious to permanently disable the rental cellular telephone of Norimatsu because the purpose of a rental phone is to be used by subsequent renters. However, we find from our review of Crossley (page 9) that "[a]lthough the telephone 10 has been described as disposable after use, alternatively it may be returned to a supplier to have the power source replenished and/or reconnected and, if necessary, new telephone numbers programmed into the memory." We observe that this disclosure of Crossley has not been brought to our attention by either the examiner or appellants. From Crossley's disclosure that as an alternative to being disposable, the phone can be replenished by the supplier, we find that Crossley teaches that the phone can either be disposable or can be reused after replenishment. From this express teaching of Crossley that the phone can either be disposable or reusable, we agree with the examiner that an artisan would have been motivated to make the reusable phone of Norimatsu disposable by rendering it inoperative subsequent to its contracted period of use.

However, we agree with appellants that because the phone of Norimatsu is disclosed as being a rental phone, we find no teaching or suggestion of providing the phone with a remaining time indicator for indicating the calling time remaining, since the phone of Norimatsu is a rental phone that does not have any limitations of calling time but rather is useable for a rental period of time.

From all of the above, we find that the examiner has failed to establish a prima facie case of obviousness of claim 12. Accordingly, the rejection of independent claim 12 under 35 U.S.C. § 103(a) is reversed. As claims 14-21 depend from independent claim 12, the rejection of claims 14-21 under 35 U.S.C. § 103(a) as reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 12 and 14-21 under 35 U.S.C. § 103(a) is reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LANCE LEONARD BARRY)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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STUART S. LEVY)	
Administrative Patent Judge)	

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